

REMARKS/ARGUMENTS

In the Office action dated July 20, 2005, the Examiner finally rejected claim 7, the only claim in this Application, under 35 U.S.C. § 103(a), as being unpatentable over U. S. Patent No. 5,319,867 to Weber in view of Applicant-supplied document entitled “PORON 90, The Ultimate in Cushioning.”

In the Specification, no changes

In the Claims, a new claim 8 is presented.

The Invention

The invention is a shoe insole which incorporates a low-rebound cushioning layer and a moisture wicking fabric material.

The Applied Art

The Technical Report for PORON 90 describes the material Applicants use for the low-rebound cushioning layer of their invention.

U. S. Patent No. 5,319,867 describes a multi layer shoe insole which reduces transfer of static electricity.

The Claims

Claim 7 requires that cushioning layer 12 be:

fully responsible for all cushioning behavior in the insole, structurally limited, with regard to cushioning-action response by it to a load-induced deformation, solely to a non-spring-back response, with said cushioning layer structure having upper and lower surfaces, and being formed throughout of an acceleration-rate-sensitive, viscoelastic, non-springy cushioning material....

The Examiner combine Applicant-supplied technical data for PORON 90 and ‘867, and insists that this combination results in Applicants’ invention, going so far to state, on page 2 of the Office action, that Rogers (the PORON 90 Technical Data) teaches an insole made of the PORON 90 material. In fact, There is no teaching nor suggestion in any of the PORON 90 Technical Data that the material be combined or laminated with any other material, nor used in a shoe insole. The Examiner’s conclusion is based solely on Applicants’ teaching - not on the applied art.

The Examiner further contends that ‘867 teach a combination of a wicking fabric with ANY cushioning material, when this is simply not the case. ‘867 suggests that the desired compression set ranges from about 1% to about 50%, according to ASTM Standard D1667-76, and prefers a range of about 5% to about 15%. Col. 3, line 65 to col. 4, line 5. PORON 90 has a compression set, as measured according to ASTM Standard 1667 of less than 5%, in any of the PORON 90 Series products. Thus, were in the inventor of ‘867 selecting a product for use in the conductive shoe sole of the invention, he would not select any of the PORON 90 Series products, as the compression set of those products is too low to fit within the preferred compression set parameters.

The Examiner’s comments regarding the use of the words “springy” and “resilience” is noted, however, the attached copy of pages from a 1960 version of Webster’s New World Dictionary clearly establishes that the Examiner’s position is wrong: resilience and springy are equivalent terms, therefor, non-resilient and non-springy are also equivalent terms. The Examiner is correct that ‘867 requires the cushioning layer to be resilient, or springy. Applicants teach away from the teaching of ‘867, thus rendering the combination of the PORON 90 material

and a fabric wicking layer non-obvious. Claim 7 is therefore allowable over the applied art.

New claim 8 incorporates the limitations of claim 7 and further requires that the cushioning material conform to a wearer's foot, as described in the Specification, page 3, line 20 to page 4, line 2. This characteristic of Applicants' invention is neither taught nor suggested by '867, nor by the PORON 90 technical data, but is the result of the combination of layers as taught and claimed by Applicants. Claim 8 is allowable over the applied art.

Applicants submit herewith a Declaration under MPEP § 716.03, wherein an officer of the owner of the instant Application provides information regarding the commercial success of the product claimed in the Application. Since the beginning of commercial sales of the product, in September, 2000, (which is less than one year prior to the filing of a U.S. Provisional Patent Application from which this Application claims priority) in excess of 21,000 pairs of insole constructed according to the invention have been moved in commerce. This product represents a retail value in excess of \$600,000.00. This volume of product would not have been commercially successful but for the unique properties obtained by Applicants through the combination of materials described and claimed in this Application. If the Examiner's obviousness rejection were well taken, given the length of time that '867 and the PORON material have been available, it would seem that others would have seen the benefits of the combination of materials long before Applicants, however, there is no evidence, and no known commercially available product, other than Applicants', which meets the needs of the marketplace as well as does Applicants' insole, which supports Applicants' contention that their invention is novel, non-obvious, and commercially successful.

In light of the foregoing amendment and remarks, the Examiner is respectfully requested to reconsider the rejections and objections state in the Office action, and pass the application to allowance. If the Examiner has any questions regarding the amendment or remarks, the Examiner is invited to contact the undersigned.

Request for Extension of time in Which to Respond

Applicants hereby request an extension of time under 37 C.F.R. § 1.136. A PTOForm 2038 Credit Card authorization is enclosed to pay the requisite extension fee. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any over-payment to Account No. 22-0258.

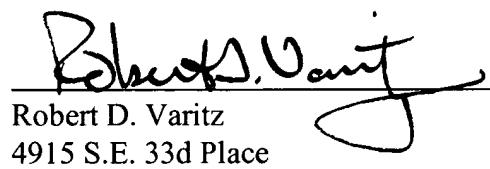
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Respectfully Submitted,

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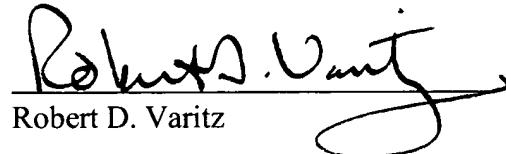


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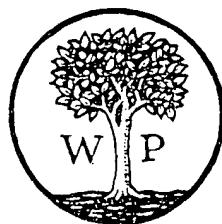
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Robert D. Varitz

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residence, *re-sid'ēns*, n. 1. dwelling for a long time; have one's residence; live (*in* or *at*): as, he still resides in the same house. 2. to be present or inherent; exist (*in*): said of qualities, etc. 3. to be vested (*in*): said of rights, powers, etc. residence (*rez'ē-dans*), n. [ME. & OFr.; ML. *residētia*], 1. the act or fact of residing; as, his residence in Europe matured him. 2. the fact or status of living or staying in a place while working, going to school, carrying out official duties, etc. (usually preceded by *in*): as, students are required to be in residence two years. 3. the place in which a person or thing resides; dwelling place; abode; especially, a house. 4. a large or imposing house; mansion. 5. the time during which a person resides in a place. residence (*rez'ē-den-sē*), n. [pl. RESIDENCES (-sēz)], 1. residence. 2. the official residence of a diplomatic officer or representative of a governor general at a foreign court, as in the East Indian native states. resident (*rez'ē-dānt*), adj. [L. *residens*], 1. residing; living in a place for a long time; having a residence (*in*). 2. living or staying in a place while working, carrying on official duties, etc.: as, a resident physician of a hospital. 3. present; inherent; intrinsic. 4. not migratory; said of birds, etc. n. 1. a person who lives in a place, as distinguished from a visitor or transient. 2. a diplomatic representative living at a foreign court or capital, as in a protectorate. 3. a bird or animal that is not migratory. residential (*rez'ē-den'shāl*), adj. 1. of or connected with residence; as, a residential requirement for students. 2. of, characterized by, or suitable for residences, or homes; as, a residential neighborhood. residentially (*rez'ē-den'shē-erē*, *rez'ē-den'shō-nē*), adj. [ML. *residētarius*], 1. living in a place; resident. 2. required to live in a place; officially resident. n. [pl. RESIDENTIARIES (-iz, -riz)], 1. a resident. 2. in ecclesiastical usage, a clergyman required to live for some time in his official residence. residual (*ri-zē'üöö-säl*), adj. 1. of, or having the nature of, residue or residuum; left over after part is taken away; remaining. 2. in mathematics: a) left by the subtraction of one number from another; as, a residual quantity. b) designating the difference (called error) between observed results and results obtained by formula computation. c) designating the deviation (called error) of any of a series of values from the mean of the series. n. 1. what is left at the end of a process; remainder. 2. in geology, an elevated rock mass remaining where erosion has leveled most of the surrounding territory; monadnock. 3. in mathematics: a) a residual quantity. b) a residual error. residuary (*ri-zē'üöö-erē*), adj. 1. of, or having the nature of, a residue or residuum; remaining; left over. 2. in law, a) receiving the residue of an estate; as, a residuary legatee. b) giving the disposition of the residue of an estate; as, the residuary clause in a will. residue (*rez'ē-doo'*, *rez'ē-dü'*), n. [ME. & OFr. *residu*; L. *residuum*, neut. of *residuus*, remaining < *residere*; see RESIDE], 1. that which is left after part is taken away; remainder; rest. 2. a residuum (sense 2). 3. in law, that part of a testator's estate which is left after all claims, charges, and bequests have been satisfied. Abbreviated res. —SYN. see remainder. residue (*ri-zē'üöö-äm*), n. [pl. RESIDUA (-ä)], [L. *residuum*, 1. a place generally in artificial lake stored for use. 2. a receptacle for a fluid, as oil, an animal or secreted. 4. a .1. [RESET, RE-
-on, type, a gem, ing reset. 3. a
zs done; deeds; circumstances.], the twentieth corresponding to t), RESHIPPING], other ship. v.t. 1. to sign another voyage. 2. reshipping. 2. tern Iran: pop. RESIDING], [Fr. *re*, to sit], 1. to

strength, spirits, good humor, etc. quickly; buoyant. —SYN. see elastic. resin (*rez'in*), n. [ME. & OFr. *resine*; L. *resina* < Gr. *rheīnē*], 1. any of various solid or semisolid organic substances exuded from various plants and trees or prepared synthetically; resins are soluble in ether, alcohol, etc., are nonconductors of electricity, and are used in medicines, varnish, etc. 2. a substance prepared by distilling the resin of certain pine trees; rosin. v.t. to treat or rub with resin. resinate (*rez'ē-nät'*), v.t. [RESINATED (-id), RESINATING], to impregnate with resin. resiniferous (*rez'ē-nif'er-əs*), adj. [see -FEROUS], yielding resin; said of trees, etc. resinoid (*rez'ē-noid*), adj. like resin; resinous. n. 1. a resinoid substance, as a synthetic resin. 2. gum resin. resinous (*rez'ē-əs*), adj. 1. of, having the nature of, characteristic of, or like resin. 2. obtained from resin. 3. containing resin. 4. [Now Rare], electronegative. resinify (*rez'ē-nī-fē*), adj. resinous. resist (*ri-zist'*), v.t. [ME. *resisten*; OFr. *resister*; L. *resistere*; re-, back + *sistere*, to set, caus. of stare, to stand], 1. to withstand; oppose; fend off; stand firm against; withstand the action of. 2. to oppose actively; fight, argue, or work against. 3. to keep from yielding to, being affected by, or enjoying: as, she tried to resist temptation. v.i. to oppose or withstand something; offer resistance. n. a substance that resists, as a protective coating on a fabric that makes it unaffected by a dye. —SYN. see oppose. resistance (*ri-zis'təns*), n. [ME. & OFr. *resistence*; LL. *resistētia*], 1. a resisting; opposing; withholding. 2. power or capacity to resist; specifically, the ability of an organism to ward off disease. 3. opposition of some force, thing, etc. to another or others. 4. in electricity, a) the property of opposing the passage of a current, causing electric energy to be transformed into heat; also called *true* (or *ohmic*) *resistance*. b) something, as a coil or length of wire, that offers such resistance; resistor. c) impedance: also called *apparent resistance*. 5. [often R-], the organized movement, often underground, of resistance to a government or occupying power regarded as oppressive and unjust, as in France during the Nazi occupation. Symbol, R (sense 4). resist-ant (*ri-zis'tant*), adj. [L. *resistens*], offering resistance; resisting. n. a person or thing that resists. resistibility (*ri-zis'təbil'i-tē*), n. the quality or state of being resistible. resistible (*ri-zis'tə-bēl*), adj. that can be resisted. resistive (*ri-zis'tiv*), adj. resisting, tending to resist, or capable of resistance. resistivity (*ri-zis'tiv-ə-tē*), n. 1. property of, capacity for, or tendency toward resistance. 2. in electricity, the resistance between opposite faces of a centimeter cube of a substance: also called *specific resistance*. resistless (*ri-zis'tlis*), adj. 1. that cannot be resisted; irresistible. 2. without power to resist; unresisting. resistor (*ri-zis'tör*), n. in electricity, a device used in a circuit primarily to provide resistance. res judicata (*réz joo'di-kä-tä*), [L. *thing decided*], in law, a case already decided by judicial authority. resole (*ré-söl'*), v.t. [RESOLED (-sold'), RESOLING], to put a new sole on (a shoe, etc.). resolubility (*réz'ə-loo-bil'i-tē*, *réz'1-yoo-bil'i-tē*), n. the quality or state of being resolvable. resoluble (*réz'ə-loo-bēl*', *réz'1-yoo-bēl*'), adj. [LL. *resolubilis*], that can be resolved. resolute (*réz'ə-lüt'*, *réz'1-lüt'*), adj. [L. *resolutus*, pp. of *resolvere*; see RE- & SOLVE], having or showing a fixed, firm purpose; determined; resolved; unwavering. —SYN. see faithful. resolution (*réz'ə-lüshən*, *réz'1-lüshən*), n. [ME. *resoluciōn*, dissolution; Late OFr. *résolution*; L. *resolutio* < *resolutus*; see RESOLUTE], 1. a) the act or process of resolving something or breaking it up into its constituent parts or elements. b) the result of this. 2. a) a resolving; determining; deciding. b) the thing resolved or determined upon; decision as to future action; resolve. 3. a resolute quality of mind. 4. a formal statement of opinion or determination adopted by an assembly or other group of persons. 5. a solving, as of a puzzle; answering, as of a question; solution. 6. in medicine, the subsidence or disappearance of an inflammation, swelling, or fever. 7. in music, a) the passing of a dissonant tone (in a chord), as an appoggiatura, to a consonant tone. b) the passing of a dissonant chord to a consonant chord or, sometimes, to another dissonant chord. c) a tone or chord to which such passing occurs. Abbreviated res. resolvability (*ri-zol'və-bil'i-tē*), n. the quality or state of being resolvable.